

**REMARKS/ARGUMENTS**

***Miscellaneous Claim Amendments***

1. Claims 6-9 have been cancelled.

***Claim Objections***

2. Claims 13-16 were rejected to. Applicant is unsure of what the Examining Attorney is objecting to and can find no MPEP section with such language. Applicant has amended claim 13 to better define the method. Applicant believes such changes overcome the rejection.

***Claim Rejections - 35 USC § 102***

3. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.

4. The Examiner rejected claims 1, 3 and 4 under §102(b) as being anticipated by Taraba, et al., U.S. Patent No. 5,701,708.

- a. Claim 1 has been amended to include the limitations that stud has a pair of ends and at least one of these ends defines (as discussed in claims 8 and/or 9) a channel for receiving either a top plate or a bottom plate therein. Such change adds no new matter.
- b. Taraba, et al., does not show such a structure. For this reason, Taraba, et al., does not anticipate the present invention in claim 1 or any of the claims that depend therefrom (claims 2-5).

5. The Examiner rejected claims 1, 6-9, 10 and 11 under §102(b) as being anticipated by Henley, et al., U.S. Patent No. 4,852,310.

- a. Claims 6-9 have been cancelled.

- b. Claim 1 has been amended to include the limitations that stud has a pair of ends and at least one of these ends defines (as discussed in claims 8 and/or 9) a channel for receiving either a top plate or a bottom plate therein.
  - c. Henley, et al., does not show such a structure. Henley, et al., shows generally C-shaped end caps for walls. For this reason, Henley, et al., does not anticipate the present invention in claim 1 or any of the claims that depend therefrom (claims 2-5).
  - d. As for claims 10-11, Applicant respectfully disagrees that Henley, et al., shows a wall panel comprised of a plurality of engineered lumber studs with top and bottom plates.
    - 1) The “studs” referred to by the Examiner aren’t even studs. They are end caps for the lower portions (74) of the posts (62).
    - 2) The “studs” referred to by the Examiner are not used to comprise a wall panel in conjunction with top/bottom plates.
    - 3) For those reasons, Henley, et al., does not anticipate the present invention in claims 10-11.
6. The Examiner rejected claims 13-16 under §102(b) as being anticipated by Aizawa, U.S. Patent No. 4,044,182.
- a. Applicant respectfully disagrees with the Examiner. Aizawa does not disclose making a plurality of cuts through first and second skins to create engineered lumber studs.
  - b. For that reason, Aizawa does not anticipate the present invention in claims 13-16.

***Claim Rejections - 35 USC § 103***

7. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 706.02(j).

8. The Examiner rejected claim 2 under §103(a) as being unpatentable (obvious) over Taraba, et al., in view of Petersen, U.S. Patent No. 4,224,774.

- a. As discussed above, Taraba, et al., does not anticipate claim 1 because claim 1 has been amended to include the limitations that stud has a pair of ends and at least one of these ends defines (as discussed in claims 8 and/or 9) a channel for receiving either a top plate or a bottom plate therein.
- b. Petersen doesn't show this limitation either.
- c. Without Taraba, et al., nor Petersen showing all limitations, a prima facie case has not been met.
- d. For this reason, the present invention is not obvious (obvious) over Taraba, et al., in view of Petersen.

9. The Examiner rejected claim 5 under §103(a) as being unpatentable (obvious) over Taraba, et al., in view of Henley, et al., U.S. Patent No. 4,852,310.

- a. Claim 5 depends from claim 1. Taraba, et al., does not anticipate claim 1 because claim 1 has been amended to include the limitations that stud has a pair of ends and at least one of these ends defines (as discussed in claims 8 and/or 9) a channel for receiving either a top plate or a bottom plate therein.
- b. As for Henley, et al.:
  - 1) The "studs" referred to by the Examiner aren't even studs. They are end caps for the lower portions (74) of the posts (62).
  - 2) The "studs" referred to by the Examiner are not used to comprise a wall panel in conjunction with top/bottom plates.
- c. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art):

‘Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.’ [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

*In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783-4 (Fed.Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

- d. The language of the claims clearly patentably distinguishes the present invention over the prior art as combined. The prior art, as combined do not show an “engineered lumber stud.” Claim 5 depends from claim 1. These claims are clearly define that the present invention (in those claims) is an engineered lumber stud. In the application, it is clear that the invented engineered lumber stud is a replacement for a traditional structural dimensional lumber stud (see [0004]-[0005]). Thus, it is clear that the present invention is a structural piece; a vertical support piece of a wall unit which supports the wall and materials attached thereto (i.e., SheetRock, etc.).
- e. Taraba, et al., shows what is referred to is a “connector stud” (52). This connector stud is not a “stud” in the traditional sense, but is a stud shaped (depth greater than width ala “2x4”). This connector stud is not a structural piece, but is an interconnector used to connect two adjacent building panels (16) together. The Taraba, et al., connector stud is no more a stud than a wood joint biscuit is.
- f. Henley, et al., on the other hand, shows a filler panel (69), which is used as an end cap for a wall for creating door or window spaces. The Henley, et al., filler panel (69) is likewise not a stud in the traditional sense. It is not structural, but more a filler piece for framing in a door space.
- g. The Examiner argues that the combination of this interconnector of Taraba, et al., and the end cap of Henley, et al., renders the present invention, an engineered structural lumber stud, obvious. Applicant disagrees.

- h. Neither of the two prior art references show an engineered structural lumber stud. Thus, it seems illogical that combining the teachings of the two references together would arrive at an engineered structural lumber stud.
- i. The Examiner has not shown nor proved any motivation exists in the references themselves to modify the prior art. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”), see also *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) (“the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”).
- j. The caselaw is clear that the Examiner must produce objective evidence of a motivation to modify the prior art.

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although “the suggestion more often comes from the teachings of the pertinent references ...” The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusionary statements regarding the teaching of multiple references, standing alone, are not “evidence.”

*In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

- k. The Applicant further argues that what the Examiner is doing is no more than hindsight reconstruction. There is no suggestion or motivation to combine the selected elements of the prior art references. The only possible incentive to make such a combination would be through hindsight reconstruction using the Applicant’s specification. Such action is improper.

[T]he Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has stated previously that “[o]ne cannot use hindsight reconstruction to pick

and choose among isolated disclosures in the prior art to deprecate the claimed invention.' [citations omitted]  
*In re Fritch*, 972 F.2d 1260, 23 USPT2d 1780, 1784 (Fed.Cir. 1992), (in part quoting from *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

1. For these reasons, Applicant disagrees that the present invention, as defined in claim 5, is obvious over Taraba, et al., in view of Henley, et al.

***Conclusion***

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 28<sup>th</sup> day of July 2005.

Very respectfully,



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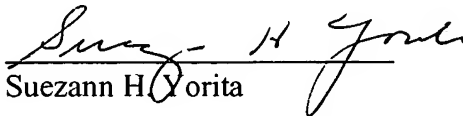
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